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10710/213 (PTG 1133 PUS)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Peot et al.

Serial No. 10/720,990

Filing Date: Nov. 24, 2003

For TABLE SAW WITH CUTTING TOOL RETRACTION SYSTEM

Examiner Alie

Group Art Unit No. 3724

PRE-APPEAL CONFERENCE REQUEST BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action mailed November 17, 2006, Applicants have filed this Pre-Appeal Brief Request for Review, as well as the accompanying Notice of Appeal. The most recent amendments to the claims in this application were filed in a Response mailed on August 24, 2006 and are already of record. Claims 1-15 are pending in this application have been twice rejected. Applicants wish to avail themselves of the expedited PTO procedure for appeals in accordance with the procedures designated in the USPTO's Official Gazette notice dated July 12, 2005.

Claims 1-15 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Published Application No. 2002/00202265 to Gass ("Gass") in view of U.S. Patent No. 2,674,130 to Spychalla ("Spychalla"), as well as being obvious over the combination of

Spychalla in view of Gass. The rejection is set forth in full in the final Office Action mailed on November 17, 2006. Applicants respectfully traverse the rejection. The Examiner fails to provide a *prima facia* case of obviousness because the combination of references does not disclose or suggest all of the limitations of the claims and because one of ordinary skill in the art would not have been motivated to combine the references without improperly referring to the claimed invention in hindsight.

The combination of Gass and Spychalla does not disclose or suggest all of the limitations of independent claim 1, let alone dependent claims 2-15. Gass discloses multiple embodiments of cutting tools that include detection systems and reaction systems that withdraw a cutting tool from a cutting zone when the detection system senses a dangerous condition. All of the embodiments disclosed or suggested by Gass include a cutting tool on an arbor that is directly connected to a motor. Accordingly, the reaction system must translate both the cutting tool and the motor concurrently upon sensing a dangerous condition. Further, Gass discloses a braking system that prevents rotation of the cutting tool, which when applied must also counteract the torque and inertia of the motor shaft directly connected to the cutting tool. Gass does not disclose or suggest the improvement of disengaging the motor from the cutting tool when the detection system senses a condition, and does not disclose that the cutting tool retracts from the cutting zone independently of the motor.

The claimed structure is preferable to Gass (and is novel and unobvious over Gass, in combination with Spychalla) because the claimed reaction system only retracts the cutting tool (and not the motor) from the cutting region upon detection of a condition, which is not disclosed or suggested by Gass. This allows the retraction system to be smaller and simpler because it must only retract the cutting tool and not the relatively heavy motor and associated structure that drives the movable cutting tool. Further, Gass does not disclose or suggest that the motor indirectly drives the cutting tool, as in claim 3, or that a belt drives the cutting tool as in claim 4.

Spychalla discloses a portable machine tool with a single motor (88) that selectively provides torque to many different rotary tools through independent belt drives. Spychalla discloses a circular saw (39), a sanding disc (101), and a grinding wheel (29)

that each are connected to the motor with independent belt drives (110', 110'', 110, respectively). The specification states that "[i]t is only necessary to engage or disengage the belts from the pulleys in order to make the machine tool active or inactive, and only one tool at a time can be used." Spychalla, Col. 5, ll. 9-13. Spychalla discloses that the sanding disc is retractable from the cutting region by way of a rotatable arm (99). When the arm is retracted or the motor is moved along a set of rails (89) the belt tension is modified, which selectively actuates or deactuates the sanding disc. Spychalla, Col. 5, ll. 5-9.

Spychalla only discloses that the position of the cutting tool or the motor can be modified manually by the user to alter the functionality of the tool. Specifically, the position of the sanding disc may be modified by rotating the arm after the user loosens a nut (106) to allow the nut and a bolt (105) to be removed from a slot (108) in the arm. *See* FIG. 10-11; Col. 4, line 67 – Col. 5, line 17. Spychalla does not disclose or suggest that it is possible to automatically disengage the cutting tool from the motor and retract the cutting tool from the cutting region independently of the motor. Spychalla does not disclose that any components of the tool can be moved or disconnected without the user physically moving the components of the tool, let alone that is possible to retract the cutting tool from the cutting region upon detection of a condition by a detection system or any other type of sensing system. In fact, Spychalla does not include anything remotely similar to a detection system.

In contrast, if the user of Spychalla was forced to manually disengage the cutting tool from the motor and retract the cutting tool from the cutting region independent of the motor after the detection system of Gass detected a condition, the user would be forced to loosen the bolt and manually swing the arm to move the cutting wheel from the cutting zone. The user would have likely cut their finger (or other foreign object that was detected by the detection system) during the finite period of time required to move the Spychalla cutting wheel to a safe position away from the cutting zone.

Accordingly, because the combination of Gass and Spychalla does not disclose or suggest all of the limitations of independent claim 1, there is no *prima facia* case of obviousness and Applicants request that the obviousness rejections of claims 1-15 be withdrawn.

Even if, *arguendo*, the combination of Gass and Spychalla disclosed all of the limitations of independent claim 1, there would still be no *prima facia* case of obviousness because there is no motivation to combine these two references. Because there is no appropriate motivation to combine Gass and Spychalla, Applicants can only assume that the rejection was made with improper hindsight reference to the underlying application. MPEP § 2145(X)(A). While Gass discloses the general concept of moving a cutting tool away from a cutting region when the detection system senses a dangerous condition (i.e. an object is in close proximity to the cutting tool) and Spychalla discloses a cutting tool that is indirectly rotated by a motor and movable with respect to the cutting zone, the two references are related to each other only to the extent that they deal with rotating cutting tools, and one of ordinary skill in the art could not have been reasonably expected to combine them.

The Federal Circuit has repeated on several occasions that a suitable motivation to combine is required to provide a *prima facia* case of obviousness, especially when a less technologically complex invention is claimed. *See In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 System, Inc.*, 157 F.3d 1340, 1351-53 (Fed. Cir. 1998). Gass and Spychalla are directed to significantly different aspects of rotating cutting systems, and neither Gass nor Spychalla provide an explicit or implicit teaching that could have rationally led to their combination without improper reference to the subject application in hindsight. *See In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). Specifically, Spychalla's cutting tools are movable with respect to the cutting zone and connected to the motor shaft with dedicated belts because Spychalla provides a single motor to operate all of the independent cutting tools. Spychalla provides structure to move the cutting tools because it would be inappropriate to operate all of the cutting tools at the same time.

Gass provides a safety system that moves a cutting tool away from the cutting zone when a dangerous condition is detected. Gass is not concerned with moving the cutting tool away from the cutting zone to allow for another separate cutting tool to be operated by the same motor. In fact, proper operation of Gass' safety system requires that the cutting tool be mounted in a consistent position or range of positions with respect to the cutting surface. For example, Gass discloses several embodiments with reaction

subsystems (24) that include brake mechanisms (28) and retraction mechanisms (e.g. 1206, FIG. 8). The proper operation of these systems necessarily requires that the cutting tool be in precise and consistent positions within the cutting zone for proper operation of the brake and/or retraction mechanism within the time parameters required to achieve Gass's goal of rapid movement of the cutting tool away from the cutting zone upon detection of a dangerous condition. This plainly teaches away from a combination with Spychalla's rotatable sanding disc on the arm.

Moreover, the Examiner's statement in the Final Rejection that the direct drive transmission of Gass and the indirect drive transmission of Spychalla are functionally equivalent remains unsupported by objective evidence, notwithstanding the statements provided in pages 7-8 therein. The direct drive mechanism of Gass and the belt drive of Spychalla operate in significantly different ways and are provided for significantly different reasons when these references are taken as a whole. MPEP § 2141.02. Because this assertion is not supported by objective evidence, it cannot lead to or be included in a conclusion that the references render the claimed invention obvious.

Further, even if one or ordinary skill in the art would have been motivated to combine Gass and Spychalla, the resulting machine would be unsuitable for its intended purpose; Gass's purpose is to provide automatic protection to the user if they come into close contact with the cutting tool. MPEP §2145(X)(D)(2). Because Spychalla's cutting tool requires operation action to move the cutting tool from the cutting zone, placing Spychalla's belt drive and movable cutting tool on Gass would render a saw blade that no longer automatically moved from the cutting zone when a dangerous condition was detected. For this additional reason, Spychalla teaches away from combination with Gass and the combination of these two references (whether Gass or Spychalla is used as the primary reference) is improper.

Because one of ordinary skill would not have been motivated to combine Gass and Spychalla absent reference to the as-filed application, there can be no *prima facia* case of obviousness and Applicants respectfully request that the rejections be withdrawn and the application be allowed to advance to allowance.

USSN 10/720,990
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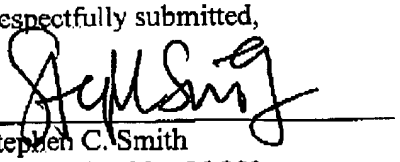
Pre Appeal Conference Request Brief

Respectfully submitted,



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